TOPICAL INDEX.

TABLE OF AUTHORITIES CITED.

CASES.

STATUTES.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 339

ROBERT A. FISCHER, THE FISCHER CORPORATION and A. S. ALOE COMPANY,

Petitioners,

vs.

F. H. BOWERS and LOUIS J. BRISTOW,

Respondents.

Respondents' Answer to Petition for Writ of Certiorari to the United States Circuit Court of Appeals for the Ninth Circuit, and Brief in Support Thereof.

To the Honorable, the Chief Justice, and the Associate Justices of the Supreme Court of the United States:

Come now the respondents, F. H. Bowers and Louis J. Bristow, answering the petition of Robert A. Fischer, The Fischer Corporation and A. S. Aloe Company for a writ of certiorari to review the judgment of the United States Circuit Court of Appeals for the Ninth Circuit, and pray for an order of this Court denying said petition.

Jurisdiction.

The Circuit Court of Appeals, herein, has decided not only a question of practice and procedure, but, also, a question involving the taking of valuable property rights of respondents without due process of law and in violation of the rules of procedure prescribed by this Court, F. R. P. C. 5(b), 52(a) and 56(c), and in violation of Section 723C of the Judicial Code and the Seventh Amendment to the Constitution of the United States.

There have been concurrent findings in this Court and in the courts below:

Refractolite Corporation v. Prismo Holding Co., 25 Fed. Supp. 965 (N. Y., 1938);

Clair v. Sears, Roebuck & Co., 34 Fed. Supp 559;

Weil v. N. J. Richman Co., Inc., 34 Fed. Supp. 401;

Frank v. Western Electric Co. (2d Cir.), 24 F. (2d) 642;

New York Belting Co. v. New Jersey Rubber Co., 137 U. S. 445, 11 S. Ct. 193, 34 L. Ed. 741.

Short Statement of the Case.

The complaint of respondents was filed in the United State District Court, Southern District of California, Central Division, at Los Angeles, California, on October 26th, 1942. [Clk. Tr. p. 9.]

F. H. Bowers was the only attorney of record for the respondents until April 12th, 1943. [Clk. Tr. p. 114.]

On December 4th, 1942, petitioners knew that Bowers resided and had his professional offices at Roseville, California, and on December 7th, 1942, through correspondence by mail obtained from Bowers a stipulation extend-

ing the time for petitioner to answer respondents' complaint. [Clk. Tr. pp. 97-98.] Roseville, California, is more than 425 miles from Los Angeles, California.

Notwithstanding the fact that petitioners knew the address of F. H. Bowers to be at Roseville, California, they mailed all notices and requests upon which they rely in this action to said Bowers at 2861 West Pico Boulevard, Los Angeles, California, which was not the *last known address* of said Bowers. (Rule 5b requires service upon the *last known* address.)

The net result of the misdirection of said mail on the part of the petitioners was that none of the notices or requests were delivered to respondents' said attorney until about the 19th day of April, 1943 [Clk. Tr. pp. 95-96], when he appeared in court at Los Angeles to resist petitioner's notice of motion for summary judgment. [Clk. Tr. p. 79.]

That within four days of the receipt of petitioners' requests for admissions, by said Attorney Bowers, the respondents filed their answer to each specific request on the 23rd of April, 1943 [Clk. Tr. pp. 53-62]; but the trial court refused to consider said answers and struck them from the record and ordered the preparation of summary judgment for the petitioner [Clk. Tr. pp. 109-110], and subsequently without any evidence, adjudged that the patent entitled "Therapeutic Light Ray Apparatus and each and every of the claims thereof, is invalid, null and void." [Clk. Tr. pp. 111-112.] No order of default was made before the answers were filed by Bowers—three weeks before the motion for summary judgment was granted.

The Judgment.

The complaint of the respondents and the answer of the petitioner placed in issue (1) the ownership and title of the patent in respondents; (2) the validity of the patent in relation to the specification of its claims; (3) whether the patentees had made a proper disclaimer of the claims alleged to be infringed; (4) whether the patent was for an apparatus whose elements and their combination were a matter of common knowledge in the art; (5) whether the apparatus had been patented in prior patents.

Obviously, each of the foregoing issues are issues of fact. Each is a material issue of fact, which must be disposed of by evidence submitted on each by witnesses competent to testify as to the fact in issue and by competent documentary evidence, not upon affidavits of parties and their attorneys that a patent is or is not void.

Furthermore, under Rule 52(a) of the Federal Rules of Civil Procedure the trial court *must make special findings of fact* on each material issue, and *must state separately its conclusions of law thereon*, and direct the entry of the appropriate judgment.

The requests for admissions submitted by petitioners, and the answers thereto submitted by the respondents, further evidence the extent and nature of these material issues, which should have been heard and determined by the trial court in accordance with Rule 52(a) before a valid judgment could be entered.

Rule 56(c) of the Federal Rules of Civil Procedure, upon which petitioner relies, provides:

> "The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, *show that,* except as to the amount of damages, *there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.*" (Italics ours.)

The state of the record in this case, even after the respondents' answers to petitioners' requests for admissions had been erroneously stricken by the trial court, was such that genuine issues of material facts remained undetermined, and the moving party was not entitled to a judgment as a matter of law.

Weil v. N. J. Richman Co., Inc., 34 Fed. Supp. 401 at p. 402;

Frank v. Western Electric Co., 24 F. (2d) 642;

New York Belting Co. v. New Jersey Rubber Co., 137 U. S. 445, 11 S. Ct. 193, 34 L. Ed. 741.

On an appeal from a summary judgment, the appellant is given the benefit of every doubt.

Weisser v. Mursom Shoe Corp., 127 F. (2d) 344.

A patent case in which both validity and infringement of the patent are in issue may not properly be disposed of upon motion for summary judgment (*Refractolite Corp. v. Prismo Holding Corp.,* 25 Fed. Supp 965; *Clair v. Sears, Roebuck & Co.,* 34 Fed. Supp 559), and particularly not upon affidavits setting forth the opinion of the plaintiff and his attorney as to the validity of the patents.

Conclusion.

The rules of the Supreme Court were revised and drafted with the intent and purpose of effecting an orderly procedure in the interests of justice. They were not intended as a substitute for the right of a trial on the merits nor to reward by a default judgment parties who seek to gain advantages by knowingly breaching the rules as to service.

The record in this case discloses that the petitioners, in disregard of the rules, misdirected their requests for admissions, by mail, to an address some 425 miles away from the "last known" office and residence of respondents' attorney, who was charged with the responsibility of answering the requests for admissions within a specified time, with the result that the attorney did not receive these documents until after the petitioners had filed their notice of motion for a summary judgment, based upon respondents' failure to answer the requests for admissions. They now seek to take advantage of their own disregard of the rules.

The respondents filed answers to the requests for admissions within four days after their attorney had received them. The trial court erroneously struck these answers filed by respondents from the files, and then ordered a summary judgment, and in its order stated that *"there is no genuine issue as to any material fact,"* and then in the following paragraph adjudged and decreed that the patent in suit, entitled *"Therapeutic Light Ray Apparatus and each and every of the claims thereof, is invalid, null and void."*

We respectfully submit that the judgment of the Ninth Circuit Court of Appeals, reversing the judgment of the trial court and giving respondents their day in court is proper, and that the petition of Robert A. Fischer, The Fischer Corporation and A. S. Aloe Company for a writ of certiorari herein should be denied. This is a court of justice not a court of technicalities!

F. H. BOWERS,
Attorney for Respondents.